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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/387,452	09/01/1999	NICHOLAS R. DONO	Y0999-294(87	2592

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EXAMINER

KLIMACH, PAULA W

ART UNIT PAPER NUMBER

2135

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/387,452

Applicant(s)

DONO ET AL.

Examiner

Paula W. Klimach

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 8-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Response to Amendment***

This office action is in response to amendment filed on 06/13/05. The amendment filed on 06/13/05 have been entered and made of record. Therefore, presently pending claims are 1-6 and 8-21.

### ***Response to Arguments***

Applicant's arguments filed 06/13/05 have been fully considered but they are not persuasive because of following reasons.

Applicant argued that Wiedemer does not disclose using the invention to gain access to the personal computer. This is not found persuasive. The system of Wiedemer as disclosed in Fig. 1 is modified to control access to the resources that are on the PC. The applicant asserts that the system of Wiedemer is for "Billing system for computer software." Thus the system controls access to computer software. Therefore the reference is broad enough to teach the software as an operating system. An operating system controls the allocation and usage of hardware resources such as memory, central processing unit time, disk space, and peripheral devices. The operating system is the foundation on which applications are built. As a result if there is no access to the operating system, there is no access to the computer.

The applicant argued further that the motivation provided by the Examiner for combining Wiedemer with Fox is the following: "at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to monitor and then billing for the use of applications on a computer as in Wiedemer in the system of Fox." This is not persuasive since

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the motivation provided by the examiner is that the combination of the system of Fox using the monitor and billing processes of Wiedemer because it would provide information as to the resources used by personnel. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The examiner asserts that Fox, Wiedemer, and Barritz do teach or suggest the subject matter broadly recited in independent Claims 1, 11, and 16. Dependent Claims 2-6, 8-10, 12-15, and 17-21 are also rejected at least by virtue of their dependency on independent claims and by other reason set forth in this office action. Accordingly, rejections for claims 1-6 and 8-21 are respectfully maintained.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-4, 6, and 8-21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Fox (4,095,739) in view of Wiedemer (5,047,928) and Barritz (EP 0 854 421 A1).

*In reference to claims 1 and 16*, Fox discloses a security system that provides access to a remote location by personnel who insert a coded data card (abstract). The system includes detecting a coupling of a portable storage device to the CA computer (remote terminals; column 3 lines 7-10), the storage device having stored therein an access code (identification number) for indicating whether an individual is authorized to temporarily access the CA computer (remote terminal) and information (column 3 lines 9-36). The system determines whether the individual is authorized to temporarily access the CA computer, based on the access code (identification number; column 3 lines 24-37).

However Fox does not expressly disclose modifying the CA, monitoring the CA, and automatically providing the bill.

Wiedemer discloses a method and system for providing access to an application running on the user computer and therefore the system provides access to the computer (Fig. 1). The reference is broad enough to teach the software as an operating system. An operating system controls the allocation and usage of hardware resources such as memory, central processing unit time, disk space, and peripheral devices. The operating system is the foundation on which applications are built. As a result if there is no access to the operating system, there is no access to the computer. The system detecting the coupling of a portable storage device to the CA computer (column 5 lines 47-50), the storage device having stored therein an access code for indicating whether the user is authorized to temporarily access the CA computer and information (Fig. 1 Part 18 and 20). The system determines whether the individual is authorized to temporarily access the CA computer, based on the key. The user has to have the right key to gain access to the data, which runs on the personal computer. As a result the systems determines

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whether the individual is authorized to temporarily (charge per-use) access the CA computer, based on the key stored in the security module. Wiedemer discloses monitoring the activity of at least one of the individual and the CA computer, until the storage device is de-coupled from the CA computer (column 13 lines 7-11). When the device is de-coupled the device will detect that the user is no longer authorized, since that authorization information is stored on the portable device. The system then generates a bill based on said monitoring (column 6 lines 16-55) and automatically providing the bill to a predetermined billing mechanism (column 6 lines 28-31). The access code (key) disclosed by Wiedemer is stored in the storage device (security module) and indicates whether the individual is authorized to temporarily use any of the plurality of application programs associated with the CA computer, and which of the plurality of application programs such authorization is provided thereto (column 7 lines 28-35). The key from the external code is used to decipher the Application program therefore only the person with the security module, and therefore the key, can use the application. The billing module is unique to each individual computer (column 7 lines 45-50). The PC is known to be able to run a plurality of applications; as a result, the device disclosed by Wiedemer provides access to a particular Application by providing the key.

Wiedemer does not disclose the information in the portable system comprising computing preferences of the individual and modifying the CA computer.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to monitor and then billing for the use of applications on a computer as in Wiedmer in the system of Fox. One of ordinary skill in the art would have been motivated to do this because it would provide information as to the resources used by personnel.

Fox and Wiedemer does not disclose the information in the portable system comprising computing preferences of the individual and modifying the CA computer in accordance with the information stored in the storage device.

Barritz discloses a system for gathering information to personalize computers available for public use (page 2 column 1-2).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to employ the teachings of gathering information to personalize the host computer disclosed by Barritz within the system disclosed by Fox. One of ordinary skill in the art would have been motivated to do this because using walk-up computers effectively requires certain configuration settings and user-related information must be established (Barritz column 1 lines 35-45).

*In reference to claim 11*, Fox discloses a security system that provides access to a remote location by personnel who insert a coded data card (abstract). The system includes detecting a coupling of a portable storage device to the CA computer (remote terminals; column 3 lines 7-10), the storage device having stored therein an access code (identification number) for indicating whether an individual is authorized to temporarily access the CA computer (remote terminal) and information (column 3 lines 9-36). The system determines whether the individual is authorized to temporarily access the CA computer, based on the access code (identification number; column 3 lines 24-37).

However Fox does not expressly disclose modifying the CA, monitoring the CA, and automatically providing the bill.

Wiedemer discloses a method and system for providing access to an application running on the user computer and therefore the system provides access to the computer (Fig. 1). Wiedemer discloses a method of generating a user account by coupling to the CA computer a portable storage device (column 3 lines 60-63) and indicating that the individual is authorized to temporarily access the CA computer (column 5 lines 1-5 in combination with column 5 lines 56-60 and column 7 lines 44-49). The external code is unique to each computer as well as providing access to the application that runs on the computer, therefore providing access to the computer (Fig. 1 part 10). The method further includes determining whether the individual is authorized to temporarily access the CA computer, based on the access code (column 5 lines 55-58). The key is used for decryption of the application and hence access to the computer to run the application. This results in providing temporary access to the CA computer (column 8 lines 3-4), charge per use is temporary dependant on the balance on the billing module, and monitoring activity of at least one of the individual and the CA computer, when the individual is authorized to temporarily access the CA computer (column 13 lines 7-11). The monitoring is terminated and a bill automatically generated, using the monitoring, when the storage device is de-coupled from the CA computer; and automatically providing the bill to a predetermined billing mechanism (column 8 lines 3-20).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to monitor and then billing for the use of applications on a computer as in Wiedmer in the system of Fox. One of ordinary skill in the art would have been motivated to do this because it would provide information as to the resources used by personnel.



Fox and Wiedemer does not disclose the information in the portable system comprising computing preferences of the individual and modifying the CA computer in accordance with the information stored in the storage device.

Barritz discloses a system for gathering information to personalize computers available for public use (page 2 column 1-2).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to employ the teachings of gathering information to personalize the host computer disclosed by Barritz within the system disclosed by Wiedemer. One of ordinary skill in the art would have been motivated to do this because using walk-up computers effectively requires certain configuration settings and user-related information must be established (Barritz column 1 lines 35-45).

*In reference to claims 2 and 17*, Wiedemer generates the bill by generating an activity log based on said monitoring and converting the activity log into the bill (column 6 lines 16-55).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to monitor and then billing for the use of applications on a computer as in Wiedemer in the system of Fox. One of ordinary skill in the art would have been motivated to do this because it would provide information as to the resources used by personnel.

*In reference to claims 3, 12, and 18*, Wiedemer further suggests inhibiting temporary access to the CA computer, when the individual is not authorized to access the CA computer (column 8 lines 3-20). The host computer only permits access only when presented with the key in the IC card (billing module).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to monitor and then billing for the use of applications on a computer as in Wiedmer in the system of Fox. One of ordinary skill in the art would have been motivated to do this because it would provide information as to the resources used by personnel.

*In reference to claim 4*, the portable storage device comprises a PCMCIA card. Fox discloses a system that uses data (column 3 lines 7-10). PCMCIA card add in cards are used for storing data.

*In reference to claims 6 and 19*, the predetermined billing mechanism disclosed by Wiedemer suggests that it is associated with one of a user account and a credit card (column 8 lines 16-18). Credit-worthy customers have credit extended to them, as is the function of the credit card; and therefore the system includes user accounts.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to monitor and then billing for the use of applications on a computer as in Wiedmer in the system of Fox. One of ordinary skill in the art would have been motivated to do this because it would provide information as to the resources used by personnel.

*In reference to claim 13*, wherein the access code stored in the storage device further indicates whether the individual is authorized to temporarily use any of the plurality of application programs associated with the CA computer, and which of the plurality of application programs such authorization is provided thereto (column 2 lines 30-41).

*In reference to claims 8, 14, and 21*, wherein the method further comprises the steps of: determining whether the individual is authorized to temporarily use any of the plurality of application programs associated with the CA computer, based on the access code (column 7 lines

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28-60); and providing temporary access to the application programs associated with the CA computer for which authorization is indicated, when the individual is authorized to temporarily use any of the plurality of application programs associated with the CA computer (column 8 lines 3-20). The user is granted temporary use because the system is a charge per-use; the user is only given access for what they have paid for. The key that is provided to the user determines the access to the applications.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to monitor and then billing for the use of applications on a computer as in Wiedmer in the system of Fox. One of ordinary skill in the art would have been motivated to do this because it would provide information as to the resources used by personnel.

*In reference to claims 9, 15, and 20*, the method wherein the portable storage device further stores therein application programs associated with the individual, and said step of providing temporary access to the CA computer further comprises the step of providing temporary access to the application programs stored in the portable storage device for execution by the CA computer. The application program disclosed by Wiedemer is stored on the floppy disc, which is portable (Fig. 1 part 12).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to consolidate the portable device and the information installed on the disc. One of ordinary skill in the art would have been motivated to do this because it would reduce the number of portable devices that the user must keep track of and therefore make it simpler for the user to keep the portable devices safe.

*In reference to claim 10*, Wiedemer further suggests the step of providing the individual with a user account by writing the access code to the portable storage device, before said step of determining whether the individual is authorized to temporarily access the CA computer. Wiedemer only provides the code in the case that the user has enough credit to use the application and therefore authorization to use the application.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to monitor and then billing for the use of applications on a computer as in Wiedmer in the system of Fox. One of ordinary skill in the art would have been motivated to do this because it would provide information as to the resources used by personnel.

**Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Fox, Wiedemer, and Barritz as applied to claim 1 above, and further in view of the Microsoft Computer dictionary.

Fox does not expressly disclose the PCMCIA card having flash memory.

The Microsoft Computer dictionary discloses flash memory being available as a PC Card plugged into a PCMCIA slot (page 199).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use flash memory as disclosed in the Microsoft computer dictionary in the PCMCIA card disclosed by Fox. One of ordinary skill in the art would have been motivated to do this because this is commonly done (Microsoft page 199).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paula W. Klimach whose telephone number is (571) 272-3854. The examiner can normally be reached on Mon to Thr 9:30 a.m to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PWK

Tuesday, August 23, 2005



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